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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/998,046
Filing Date: November 29, 2001
Appellant(s): DIETZ ET AL.

J.B. Kraft (Reg. No. 19,226)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 25, 2008 appealing from the Office action mailed 12/03/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,765,138	Aycock et al.	06-1998
2002/0049642	Moderegger et al.	04-2002
6,691,148	Zinky et al.	02-2004
6,647,374	Kansal	11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1, 3, 5, 7, 9-11, 13, 15, 17, 19-20, 31, 33, 35, 37 and 39-40 are rejected under 35 U.S.C. 103 (a) being unpatentable over Aycock et al., U.S. Patent No. 5,765,138 (reference A in attached PTO-892) in view of Moderegger et al., U.S. Pub No. 2002/0049642 (reference B in attached PTO-892) further in view of Zinky et al., U.S. Patent No. 6,691,148 (reference C in attached PTO-892).

3. As per claim 1, Aycock et al. teach a computer controlled display system for generating quality assurance assessment for software suppliers comprising:

means for assessing the quality level of each of a set of quality attributes of said

software suppliers (see Fig. 1 ; column 6, lines 1-5; where quality level of each of set of quality attributes of software supplier specified in Request for Proposal/Request for Quotation (RFP/RFQ) assessed with help of selected set of supplier quality process maturity requirement established in Step 12); and

means for generating for each of said quality attributes at least one requirement for said supplier based upon the quality level of said attribute (see Fig. 1 ; column 3, lines 15-18; where requirement for supplier site evaluation is generated in tier 2 after calculating supplier maturity level in tier 1), wherein said contract requirement involves tracking and reporting of said software development (see Fig. 1, step 46; column 27-46).

Aycock et al. do not teach generation of contract requirement after assessing the supplier.

Moderegger et al. teach generating a contract list of performances after successful bidding of the contract (see Fig. 4b; page 4, paragraph [0056]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow generation of contract requirement after assessing the supplier of Aycock et al. because Moderegger et al. teach that allowing generation of contract requirement after assessing the supplier ensure to meet procedural requirement, product quality requirement, performance specifications and timely delivery at various stages by the supplier (Moderegger et al., paragraph [0009]).

Aycock et al. do not teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute.

Zinky et al. teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute (Zinky et al., Figs. 3-5; column 3, lines 8-20; column 7, lines 30-60).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute of Aycock et al. because Zinky et al. teach that allowing above features enables to evaluate the contract to select a level of quality of service that correspond to a current quality of service provided by the network (Zinky et al., column 3, lines 11-16).

4. As per claim 3, Aycock et al. in view of Moderegger et al. teach claim 1 as described above. Aycock et al. further teach the computer controlled display system, wherein

no contract requirement is generated for at least one of said quality levels for at least one of said quality attributes (see Fig. 1; column 7, lines 46-54; where if a supplier is a regular and established vendor of other projects with excellent historical vendor performance and meets minimum maturity level, then the supplier may be automatically approved without requiring to go through tier 2).

5. As per claim 5, Aycock et al. in view of Moderegger et al. teach claim 1 as described above. Aycock et al. further teach the computer controlled display system, wherein:

said set of quality attributes consists of a single overall quality characteristic having several predetermined quality levels (see column 6, lines 37-54; column 7, lines 37-45: where overall maturity level is calculated at step 26 such as level 2 for repeatable process, level 3 for standardized process) ; and

Aycock et al. teach how to determine supplier quality process maturity requirement selected based on maturity levels (see Fig. 1, step 42 and 44; column 7, lines 37-45). Aycock et al. do not teach means for generating plurality of contract requirements.

Zinky et al. teach means for generating plurality of contract requirements for each of said predetermined quality levels (see column 3, lines 8-20).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow means for generating plurality of contract requirements for each of said predetermined quality levels of Aycock et al. because Zinky et al. teach that allowing above features enables to evaluate the contract to select a level of quality of service that correspond to a current quality of service provided by the network (Zinky et al., column 3, lines 11-16).

6. As per claim 7, Aycock et al. in view of Moderegger et al. teach claim 1 as described above. Aycock et al. further teach the computer controlled display system, wherein:

said contract requirement involves tracking and reporting of testing of said software (see Fig. 1, step 46; column 27-46).

7. As per claim 9, Aycock et al. in view of Moderegger et al. teach claim 1 as described above. Aycock et al. further teach the computer controlled display system, wherein:

said contract requirement involves the management processes of said supplier (see column 8, lines 26-31; where on-site review of supplier include review of quality control processes and procedure, and site evaluation by production engineers and production control managers responsible for production scheduling).

8. As per claim 10, Aycock et al. in view of Moderegger et al. teach claim 1 as described above. Aycock et al. further teach the computer controlled display system, wherein:

said display system assigns said software supply function to said software supplier in an overall work flow distribution system (see Fig 2 ; column 11, lines 2-4; where the display system assigns the supplier to respond to RFP/RFQ).

Aycock et al. do not teach means for generating automatically generate and distribute said contract requirements to said supplier in response to the selection of said supplier.

Moderegger et al. teach means for generating automatically generate and distribute said contract requirements to said supplier in response to the selection of said supplier (see page 9, paragraph [0056]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow means for generating automatically generate and distribute said contract requirements to said supplier in response to the selection of said supplier of Aycock et al. because Moderegger et al. teach that allowing means for generating automatically generate and distribute said contract requirements to said supplier in response to the selection of said supplier ensure to meet procedural requirement, product quality requirement, performance specifications and timely delivery at various stages by the supplier (Moderegger et al., paragraph [0009]).

9. As per claim 11, Aycock et al. teach a method for generating, on a user interactive computer controlled display system, quality assurance contract requirements for software suppliers comprising:

assessing the quality level of each of a set of quality attributes of said software supplier (see Fig. 1; column 6, lines 1-5; where quality level of each of set of quality attributes of software supplier specified in Request for Proposal/Request for Quotation (RFP/RFQ) assessed with help of selected set of supplier quality process maturity requirement established in Step 12); and

generating for each of said quality attributes at least one requirement for said supplier based upon the quality level of said attribute (see Fig. 1; column 3, lines 15-18; where requirement for supplier site evaluation is generated in tier 2 after calculating supplier maturity level in tier 1), wherein said contract requirement involves tracking and reporting of said software development (see Fig. 1, step 46; column 27-46).

Aycock et al. do not teach means for generation of contract requirement after assessing the supplier.

Moderegger et al. teach means for generating a contract list of performances after successful bidding of the contract (see Fig. 4b; page 4, paragraph [0056]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow generation of contract requirement after assessing the supplier of Aycock et al. because Moderegger et al. teach that allowing generation of contract requirement after assessing the supplier ensure procedural requirement, product quality requirement, performance specifications and timely delivery at various stages by the supplier (Moderegger et al., paragraph [0009]).

Aycock et al. do not teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute.

Zinky et al. teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute (Zinky et al., Figs. 3-5; column 3, lines 8-20; column 7, lines 30-60).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute of Aycock et al. because Zinky et al. teach that allowing above features enables to evaluate the

contract to select a level of quality of service that correspond to a current quality of service provided by the network (Zinky et al., column 3, lines 11-16).

10. As per claim 13, Aycock et al. teach claim 11 as described above. Claim 13 is rejected under same rational as claim 3.

11. As per claim 15, Aycock et al. teach claim 11 as described above. Claim 15 is rejected under same rational as claim 5.

12. As per claim 17, Aycock et al. teach claim 11 as described above. Claim 17 is rejected under same rational as claim 7.

13. As per claim 19, Aycock et al. teach claim 11 as described above. Claim 19 is rejected under same rational as claim 9.

14. As per claim 20, Aycock et al. teach claim 11 as described above. Claim 20 is rejected under same rational as claim 10.

15. As per Claim 31, Aycock et al. teach a computer program comprising a computer useable medium having a computer readable program, wherein the computer readable program when executed on a computer causes the computer to:

assess the quality level of each of a set of quality attributes of said software supplier (see Fig. 1 ; column 6, lines 1-5; where quality level of each of set of quality attributes of software supplier specified in Request for Proposal/Request for Quotation (RFP/RFQ) assessed with help of selected set of supplier quality process maturity requirement established in Step 12); and

generate for each of said quality attributes at least one requirement for said

supplier based upon the quality level of said attribute (see Fig. 1; column 3, lines 15-18; where requirement for supplier site evaluation is generated in tier 2 after calculating supplier maturity level in tier 1), wherein said contract requirement involves tracking and reporting of said software development (see Fig. 1, step 46; column 27-46).

Aycock et al. do not teach means for generation of contract requirement after assessing the supplier.

Moderegger et al. teach means for generating a contract list of performances after successful bidding of the contract (see Fig. 4b; page 4, paragraph [0056]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow generation of contract requirement after assessing the supplier of Aycock et al. because Moderegger et al. teach that allowing generation of contract requirement after assessing the supplier ensure procedural requirement, product quality requirement, performance specifications and timely delivery at various stages by the supplier (Moderegger et al., paragraph [0009]).

Aycock et al. do not teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute.

Zinky et al. teach means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute (Zinky et al., Figs. 3-5; column 3, lines 8-20; column 7, lines 30-60).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow means for dynamically determining one of a plurality of quality levels for each of said set of quality attributes and means for generating a different contract requirement for each of said quality levels for each attribute of Aycock et al. because Zinky et al. teach that allowing above features enables to evaluate the contract to select a level of quality of service that correspond to a current quality of service provided by the network (Zinky et al., column 3, lines 11-16).

16. As per claim 33, Aycock et al. teach claim 31 as described above. Claim 33 is rejected under same rational as claim 3.

17. As per claim 35, Aycock et al. teach claim 31 as described above. Claim 35 is rejected under same rational as claim 5.

18. As per claim 37, Aycock et al. teach claim 31 as described above. Claim 37 is rejected under same rational as claim 7.

19. As per claim 39, Aycock et al. teach claim 31 as described above. Claim 39 is rejected under same rational as claim 9.

20. As per claim 40, Aycock et al. teach claim 31 as described above. Claim 40 is rejected under same rational as claim 10.

21. Claims 8, 18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al., U.S. Patent No. 5,765,138(reference A in attached PTO-892) in view Moderegger et al.(reference B in attached PTO-892) further in view of Zinky et al., U.S.

Patent No. 6,691,148 (reference C in attached PTO-892) and further in view of Kansal, U.S. Patent No. 6,647,374 (reference D in attached PTO-892).

22. As per claims 8 and 18 and 38, Aycock et al. in view of Moderegger et al. further in view of Zinky et al. do not teach contract requirement involving software supplier risk identification and reduction.

Kansal teaches the contract requirement involves software supplier risk identification and reduction (see Fig. 5, steps 66-72; Fig. 6 and 7; column 3, lines 55-67 to column 4, lines 1-11, 60-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow contract requirement that involves software supplier risk identification and reduction of Aycock et al. in view Moderegger et al. because Kansal teaches that allowing contract requirement that involves software supplier risk identification and reduction would enable customer to hedge their risk of using various technology vendors (Kansal, column 12, lines 42-45).

(10) Response to Argument

A. Claim 1, 3, 5, 7, 9-11, 13, 15, 17, 19-20, 31, 33, 35, 37 and 39-40 are rejected under 35 U.S.C. 103 (a) being unpatentable over Aycock et al., U.S. Patent No. 5,765,138 (reference A in attached PTO-892) in view of Moderegger et al., U.S. Pub No. 2002/0049642 (reference B in attached PTO-892) further in view of Zinky et al., U.S. Patent No. 6,691,148 (reference C in attached PTO-892).

Followings are the list of arguments of the appellant against the combination of references used by the Examiner for rejection of above claims in the instant application:

1) Examiner has used Appellant's own teachings in combining the three references and then combined elements from each of three each of three references with hindsight based solely upon Appellant's own teachings;

2) The combined references would not render claimed invention obvious based on the combination of references under 35 USC 103, i.e. there would still be elements of the present claimed invention missing from the proposed combination of references; and

3) In Zinky, every assessment is done during performance of a completed contract and consequently, there is no suggestion of contract requirement generated as a result of any assessment of the supplier (corrected).

In response to appellant's argument 1 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention (Rationale A). Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Boyd and Ovadia into the disclosure of Pentel and the results would have been predictable to one of ordinary skill in the art (Rationale D).

In other words, as conceded by the Appellant in the Appeal Brief, Aycock et al. teach interactive computer assessment of potential supplier (page 11, second

paragraph); Moderegger et al. teach assessing supplier to generate contract provision or requirement (see page 11, third paragraph); and Zinky teaches providing contract for a vendor or supplier which recites quality levels for plurality of performance attributes (see page 12, paragraph) and group of attributes are tracked to determine quality level performance of the particular attribute and generate adjustments as per contract, if any falls below predetermined requirement (see page 12, first and second paragraph). It is to be noted that Final Office action referred Zinky et al. for "dynamically determining one of a plurality of quality levels of each of said set of quality attributes and means for generate different contract requirement for each of said quality levels for each attribute (Zinky et al., Figs. 3-5, column 3, lines 8-20; column 7, lines 30-60" and Moderegger et al. for "generating list of performance requirement after assessing the bidders (or supplier) (Moderegger, page 9, paragraph [0056])". The combination of three references, therefore, meet limitation of above claims in this application.

As per argument 2, Appellant fails to specify what element would be missing in the combination of three references except those described in the argument 3.

In response to appellant's argument 3 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., supplier assessment is for performance of a new contract not for a completed contract) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moderegger et al. teach generating contract requirement after assessing the bidders (or supplier)

(Moderegger, Fig. 4b, paragraph [0056]). Zinky teaches evaluation of each quality attributes and provide contract requirement to make adjustment to given quality level (Zinky, column 3, lines 11-16)

B. Claims 8, 18 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al., U.S. Patent No. 5,765,138(reference A in attached PTO-892) in view Moderegger et al.(reference B in attached PTO-892) further in view of Zinky et al., U.S. Patent No. 6,691,148 (reference C in attached PTO-892) and further in view of Kansal, U.S. Patent No. 6,647,374 (reference D in attached PTO-892).

The Appellant conceded that Kansal discloses contract requirement involving software risk identification and reduction (see page 13, third paragraph). The rejection of claims 8, 18 and 38 stands.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted.

/Bijendra K. Shrestha/

Patent Examiner

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